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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/926,185	04/01/2002	Steve Worthington	P67146US0	2831
136	7590	09/20/2004	EXAMINER	
JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			VO, TED T	
			ART UNIT	PAPER NUMBER
			2122	

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/926,185	Applicant(s) WORTHINGTON ET AL.	
	Examiner Ted T. Vo	Art Unit 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE

3 MONTH(S) FROM

THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/19/02</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the application filed on 04/01/2002.
Claims 1-2 are pending in the application.

Information Disclosure Statement

2. Some contents of information disclosure statement filed on 3/19/02, which are not marked with initials, do not comply with the requirements under 37 CFR 1.98(a)(5): Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.

In this particular case, these contents, which cite solely websites (place of publication) and accessed dates of the websites (date), fail to fully comply with the requirement in accordance to 37 CFR 1.98(a)(5).

It has been placed in the application file, but the contents referred to therein have not been considered. See MPEP 609.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority, NEW ZEALAND, No. 506004, under 35 USC 119(a-d). However, the certified document, NEW ZEALAND, No. 506004, is not received.

Specification

4. The specification is object to because the Brief Description Of The Drawings fails to give the brief descriptions of FIG. 9.

Correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ahonen et al., "Assembling Documents from Digital Libraries", 1997.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Ahonen discloses, "A document assembly system resident on a web server which allows a user with web connectivity and a browser to invoke said system and interactively assemble a document at the web server comprising:

a stored library of packets of text each relating to a different document and each document packet containing blocks of text that will meet a variety of possible contingencies for a document of that type (See page 3, Section 2.1: Structure of the Documents: referring to 'digital library'. See page 7, section 3.1: referring to 'Document fragments', or 'document collections'),

means which dynamically create web pages applicable to a document which present document determining queries to the user's browser and capture decisions made by said user in response, together

with unique user input data relevant only to the particular document being assembled (See Fig.1, 'browsing', 'tailored document', and see page 3, section 2: System for Tailoring Textbooks via WWW),

means which selects from said library blocks of language based on said user decisions, (See page 4, section 2.2, indentation 1, 'The client fills in an HTML form and submits it.') a database which stores said user data, software that assembles said blocks of language and populates the assembled document with said user data (See page 5, Fig. 3, 'WWW server', 'Technical editor' (database), see page 2, whole Fig. 1, 'Assembly process' (assembled document)),

means for delivering the assembled document to said user" (See Fig. 3).

As per Claim 2: Ahonen discloses, "Authoring software for the creation of interactive web pages for a document assembly system resident on a web server comprising:

WP application software which allows the creation of standard text for each of a plurality of documents and which incorporates macros and data fields (See page 5, Fig.3, 'WWW browser', See page 4, section 2.2, indentation 1, 'The client fills in an HTML form and submits it.' (WP application software)),

software which includes:

means which creates interactive web pages for said web server (See page 5, Fig.3, 'WWW browser' and 'WWW server'),

said pages constructed to in use present document determining queries to a user and capture decisions made by said user in response, together with unique user data input (See Fig. 1, 'querying' and further referring to an association of 'querying' of Fig.1 with Fig. 3),

means which establish rules for the storage of said user decisions and data input (See page 5, Fig.3, 'assembly rules, content information'),

means which generate document-specific macros and fields for document text in said WP application (See Fig. 1, referring to tailored document'), and

means which select and trigger appropriate macros based on decisions captured by said web pages and populates appropriate fields with user input data." (See page 5, Fig. 3, 'WWW browser').

Art Unit: 2122

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grow, US No. 6,694,315 B1, discloses an online document assembly and docketing method using a user workstation interconnected over a network.

Mital et al., "A Neural Network Integrated with Hypertext for Legal Document Assembly", 1992 IEEE, discloses using Hypertext in a Legal Document Assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (703) 308-9049. The examiner can normally be reached on 8:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (703) 305-4552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

After October 25, 2004, examiner can be reached at new telephone number (571) 272-3706 and the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3694.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TED T. VO

TTV
Patent Examiner
Art Unit 2122
September 9, 2004